

REMARKS

I. CLAIM STATUS

Claims 39-53 and 55-76 are pending after this amendment. Specifically, claims 74 and 75 have been amended to recite the inclusion of at least one emulsifier. Claims 39, 59, and 74-76 have been amended to (1) incorporate the limitations of claim 54 without the recitation of "alcohols" and (2) recite the proviso that the emulsifier may not be an alkoxylated alkyl phenol. Accordingly, claim 54 has been cancelled. Section 112 support for these amendments may be found in the specification-as-filed, including the original claims and page 13's recitation regarding alkoxylated alkyl phenols. *See e.g., In re Johnson*, 194 U.S.P.Q. 187, 197 (C.C.P.A. 1977) (Section 112 support exists when claiming less than the full measure of what is disclosed in the specification). Accordingly, no new matter has been added by this amendment.

Applicants thank the Office for the withdrawal of the June 19, 2009, Restriction Requirement. Office Action at 2.

II. ART REJECTIONS

A. The Office has rejected claims 39, 43, 44, 47-49, 51-59, 63, 64, and 66-76 under 35 U.S.C. §103(a) as being unpatentable over DE 100 03 105 A1 to Huffer et al. for the reasons provided in the Office Action at pp. 2-3.¹ Applicants traverse for the following reasons.

¹ Applicants understand that U.S. Patent Appln Publ. 2003/0024852 A1 is an English-language application corresponding to DE 10003105 A1, and rely on its disclosure to respond to the current rejection. Thus, citations to Huffer refer to this U.S. publication.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Huffer discloses the use of alkoxyated polyisobutenes as emulsion stabilizers for fuel/water emulsions. Huffer at ¶¶ 13-14. The only identified disclosure by Huffer of an oxygen-containing water soluble organic compound that is suitable for its emulsions are C₁-C₄ alcohols. Huffer at ¶¶ 23-24. However, such alcohols do not meet the limitation that “the at least one oxygen-containing water soluble organic compound is selected from glycols, polyols, ethers, ketones, and mixtures thereof.” The Office needs to provide a basis to modify the teachings of Huffer to obtain the claimed invention with a reasonable expectation of success.

Accordingly, since Huffer does not teach or suggest the claimed invention, the current rejection should be withdrawn.

B. The Office has rejected claims 39, 43, 44, 47-49, 51-54, 57-59, 63, 64, and 66-76 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 3,756,794 to Ford ("Ford") for the reasons provided in the Office Action at p. 3. Applicants traverse for the following reasons.

Ford discloses a "unique water-soluble non-ash forming emulsion stabilizer," *i.e.*, urea or formamide. Ford, col. 1, lines 19-21, 35-36. Ford's compositions were narrowly defined ("consisting essentially of") as hydrocarbon fuel, emulsifier, water, and its new emulsion stabilizer. *Id.* at col. 1, lines 34-38. The only disclosed emulsifiers are "condensate[s] of an alkyl phenol and an alkylenoxide," *i.e.*, alkoxyated alkyl phenols. *Id.* at col. 2, lines 3-13, Examples. However, alkoxyated alkyl phenols as emulsifiers are expressly excluded from the claims. The Office needs to provide a basis to modify the teachings of Ford to obtain the claimed invention with a reasonable expectation of success.

Accordingly, since Ford does not teach or suggest the claimed invention, the current rejection should be withdrawn.

C. The Office has rejected claims 59-69, 72, and 73 under 35 U.S.C. §102(b) as being anticipated by EP-A-0 399 620 to Genova et al. ("Genova I") for the reasons provided in the Office Action at pp. 3-4. Applicants traverse for the following reasons.

Genova I discloses a "hybrid diesel fuel composition in the form of a microemulsion. . . [that] comprises a diesel fuel, water, a glycolipid surfactant and an aliphatic alcohol co-surfactant." Genova I, abstract. However there is no anticipation because Genova I does not meet the limitation that "the at least one oxygen-containing

water soluble organic compound is selected from glycols, polyols, ethers, ketones, and mixtures thereof.” See M.P.E.P. § 2131 (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”) (citation omitted).

Accordingly, since Genova I does not teach or suggest the claimed invention, the current rejection should be withdrawn.

D. The Office has rejected claims 59-69, 72, and 73 under 35 U.S.C. §102(b) as being anticipated by US Patent No. 5,004,479 to Schon et al. (“Schon”) for the reasons provided in the Office Action at p. 4. Applicants traverse for the following reasons.

Schon discloses a “novel fuel composition compris[ing] (a) a hydrocarbon fuel. . . ; (b) water; and (c) a cosurfactant system of methyl alcohol in combination with a fatty acid neutralized . . . with a nitrogenous base.” Schon, col. 3, lines 45-51. However there is no anticipation because like Huffer and Genova, Schon does not meet the limitation that “the at least one oxygen-containing water soluble organic compound is selected from glycols, polyols, ethers, ketones, and mixtures thereof.” See M.P.E.P. § 2131.

Accordingly, since Schon does not teach or suggest the claimed invention, the current rejection should be withdrawn.

E. The Office has rejected claims 59-64, 66, 69, 72, and 73 under 35 U.S.C. §102(b) as being anticipated by EP-A-0 441 002 to Genova et al. (“Genova II”) for the

reasons provided in the Office Action at pp. 4-5. Applicants traverse for the following reasons.

Genova II discloses a "hybrid diesel fuel composition in the form of a stable water-in-oil microemulsion [that] comprises a liquid hydrocarbon fuel, water, a glycolipid surfactant and a vicinal aliphatic diol co-surfactant." Genova II, abstract. It is Applicants' understanding that a person of ordinary skill in the art would recognize that the vicinal aliphatic diol co-surfactants, as described at page 3, lines 7-20, are not deemed water soluble. Hence there can be no anticipation since Genova II does not meet the limitation that "the at least one oxygen-containing water soluble organic compound is selected from glycols, polyols, ethers, ketones, and mixtures thereof." *See* M.P.E.P. § 2131

Accordingly, since Genova II does not teach or suggest the claimed invention, the current rejection should be withdrawn.

F. The Office has rejected claims 40-42, 45, 46, and 50 under 35 U.S.C. §103(a) as unpatentable over Huffer et al. in view of U.S. Patent No. 6,598,584 to Beck et al. ("Beck") for the reasons provided in the Office Action at p. 5. Applicants traverse for the following reasons.

As noted above Huffer does not teach or suggest the subject matter of claim 39 and, thus, does not teach the subject matter of claims 40-42, 45, 46, and 50, which depend therefrom. Beck does not appear to correct the deficiencies of Huffer.

Accordingly, the rejection over Huffer and Beck should be withdrawn.

III. EXAMINER'S REQUEST

The Examiner requested that Applicants provide "a copy of the search report alluded to in the preliminary examination report for PCT/EP02/03534." Office Action at 2. Applicants note that Office stated on March 9, 2005, that it had received this international search report. Nevertheless, Applicants attach a copy for the Examiner's convenience.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: May 21, 2010

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Attachment: International Search Report for PCT/EP02/03534